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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,768	07/13/2001	Florence L'Alloret	210578US0	1465
22850	7590	03/02/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 03/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/903,768

Applicant(s)

L'ALLORET ET AL.

Examiner

Tae H. Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-35 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-28, 34, 35 and 39-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

The allowability indicated in the last office action is withdrawn due to new ground of rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11, 13-28, 34, 35 and 39-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 5,925,341 in view of Woodward et al (US 3,301,829), Frerker et al (US 3,390,010), Yoshida et al (US 6,440,431) and Midha et al (US 2002/0012645).

Claims of US Patent No. 5,925,341 teach an oil-in-water nanoemulsion containing nonionic amphiphilic lipid, ionic amphiphilic lipid and aminated silicones oil and its use. The instant ratio of an oil or oil phase to amphiphilic lipid and sizes of oil globules are seen in claims 1-3 and 30-32. The instant invention further recites employing thickeners (water-soluble nonionic polymers) over Cervantes et al. However, the instant thickeners are well known in the art as taught by Woodward et al (col. 1, lines 16-21, col. 3, line 56 and col. 4, line 16, col. 4, line 42 and col. 6, lines 60-62), Frerker et al (col. 2, lines 37-39 and examples 4 and 5), Yoshida et al (col. 8, lines 20-

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31), Midha et al ([0152]), Friedman et al (col. 6, lines 23-25), Binns et al (col. 8, lines 15-27), Bernecker et al (col. 4, lines 5-8) and Suzuki et al (col. 8, lines 1-5).

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known thickener of Woodward et al, Frerker et al, Yoshida et al, Midha et al, Friedman et al, Binns et al, Bernecker et al and/or Suzuki et al in Cervantes et al since the use of the instant thickeners in emulsion compositions for cosmetic compositions is a routine practice in the art.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13-28, 34, 35 and 39-42 are rejected under 35 U.S.C. 103(a) as obvious over Cervantes et al (US 5,925,341) in view of Woodward et al (US 3,301,829), Frerker et al (US 3,390,010), Yoshida et al (US 6,440,431), Midha et al (US 2002/0012645) Friedman et al (US 6,004,566), Binns et al (US 6,287,377), Bernecker et al (US 6,569,414) and/or Suzuki et al (US 6,432,439).

Cervantes et al teach an oil-in-water nanoemulsion containing nonionic amphiphilic lipid, ionic amphiphilic lipid and aminated silicones oil in examples and said nanoemulsion would meet the instant viscosity and turbidity since the objective of the invention is the same. Various sizes of oil globules such as 95 nm, 79 nm, 62 nm,

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79 nm, 70nm, 48 nm and 54 nm are seen in said examples. The instant ratio of an oil or oil phase to amphiphilic lipid is seen in claims 1-3. Claims 14-39 of Cervantes et al further teach the instant invention. Cervantes et al further teach employing thickeners at col. 12, lines 34-44.

The instant invention further recites employing different thickeners (water-soluble nonionic polymers) over Cervantes et al. However, the instant thickeners are well known in the art as taught by Woodward et al (col. 1, lines 16-21, col. 3, line 56 and col. 4, line 16, col. 4, line 42 and col. 6, lines 60-62), Yoshida et al (col. 8, lines 20-31), Frerker et al (col. 2, lines 37-39 and examples 4 and 5), Midha et al ([0152]), Friedman et al (col. 6, lines 23-25), Binns et al (col. 8, lines 15-27), Bernecker et al (col. 4, lines 5-8) and Suzuki et al (col. 8, lines 1-5).

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known thickener of Woodward et al, Frerker et al, Yoshida et al, Midha et al, Friedman et al, Binns et al, Bernecker et al and/or Suzuki et al in Cervantes et al since Cervantes et al teach employing various natural and synthetic thickeners and since the use of the instant thickeners in emulsion compositions is a routine practice in the art.

Claims 1-11, 13-28, 34, 35 and 39-42 are rejected under 35 U.S.C. 103(a) as obvious over Cervantes et al (US 5,925,341) in view of Woodward et al (US 3,301,829), Yoshida et al (US 6,440,431), Midha et al (US 2002/0012645) Friedman et al (US 6,004,566), Binns et al (US 6,287,377), Bernecker et al (US 6,569,414) and/or Suzuki et

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al (US 6,432,439), and further in view of FR 2 787 027 or Simonnet et al (US 6,274,150, 6,375,960 or 6,464,990).

Also, the instant turbidity is well known in oil-in water cosmetic and pharmaceutical emulsion compositions as taught by FR (page 2, lines 30-40) and Simonnet et al (top of col. 3 in US'150 and '960 and col. 3, lines 25-30 of US'990).


It would have been obvious to one skilled in the art at the time of invention to utilize the art well known thickener of Woodward et al, Frerker et al, Yoshida et al, Midha et al, Friedman et al, Binns et al, Bernecker et al and/or Suzuki et al in Cervantes et al since Cervantes et al teach employing various natural and synthetic thickeners and since the use of the instant thickeners in emulsion compositions is a routine practice in the art, and the instant turbidity is well known in oil-in water cosmetic and pharmaceutical emulsion compositions as taught by FR and Simonnet et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon  
Primary Examiner  
Art Unit 1714

THY/February 28, 2005